

Application No. 10/658,437

Restriction Requirement mailed June 17, 2005

Response to Restriction Requirement filed August 17, 2005

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The foregoing election is made with traverse. Applicants request that Group II, a method for obtaining a cell culture of propagating pancreatic cells; and Group III, a method for differentiating the cell culture to make an aggregate of insulin producing cells, be examined together, as all the required method steps in Group III are also found in Group II.

Applicants also assert that, at the very least, claim 6 is a genus claim linking the dependent species claims to methods that require the same steps, *i.e.*, methods of obtaining a cell culture and then differentiating that culture to make an aggregate of insulin producing cells. As such, upon allowance of a linking genus claim, the restriction requirement should be withdrawn with respect to the species claims. MPEP 809.03. Applicants further note that when the requirement for restriction is predicated upon the non-allowability of a generic linking claim, Applicant is entitled to retain in the case claims to the non-elected invention. If the generic linking claim is allowed, the Examiner must then examine non-elected claims to species falling within the genus. MPEP 809.04.

Finally, restriction of an application is discretionary. A restriction requirement is made to avoid placing an undue examination burden on the Examiner and the Office. Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. MPEP 803.01. Applicants respectfully submit that examining the claims of Groups II and III together (methods of obtaining a cell culture and then differentiating that culture to make an aggregate of insulin producing cells) would not place and undue burden on the Examiner. Applicants therefore respectfully request that the restriction requirement with respect to Groups II and III be withdrawn.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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Attachments

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